



DOCKET NO: 0524-2769-0 PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

BERND BRUCHMANN, ET AL.

: EXAMINER: SERGENT, R. A.

SERIAL NO: 08/894,156

:

FILED: AUGUST 15, 1997

: GROUP ART UNIT: 1711

FOR: PREPARATION OF BIURET-
CONTAINING POLYISOCYANATES

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This Reply Brief is in reply to the Examiner's Answer dated May 19, 2004 (Answer).

At the outset, Appellants confirm all the arguments made in the Appeal Brief, most of which have not even been responded to in the Answer.

The Examiner finds that one of ordinary skill in the art "would have been motivated to utilize the nitrogen-containing biuretizing agents of [Wagner et al and Hennig et al] **in place of** the amine component of [Möhring et al], because one would have reasonably expected the nitrogen compounds of [Möhring et al] and [Wagner et al and Hennig et al] to function as equivalents, in view of the teachings within [Wagner et al and Hennig et al]" (Answer at 4, emphasis added).

In reply, Möhring et al specifically require the presence of alcohol and amine, and optionally water, as the biuretizing agent therein. While Wagner et al and Hennig et al may disclose various nitrogen-containing compounds as biuretizing agents, it is only with the present disclosure as a guide that one skilled in the art would regard such nitrogen-containing

compounds as equivalent to the amines of Möhring et al in Möhring et al's biuretizing agent. Moreover, even if one skilled in the art were to make the substitution as found by the Examiner, the result would still not be the presently-claimed invention, which requires that any nitrogen-containing stabilizer of the present claims be present in an amount less than the corresponding amounts of nitrogen-containing biuretizing agents disclosed in the cited references.

To the extent the Examiner finds that it would have been obvious to combine the biuretizing agents of the cited references (Answer at 4), Appellants have shown, in the comparative data of record, that results are obtained in the presently-recited combination that could not have been predicted by the applied prior art.

The Examiner finds, with regard to Claims 16 and 17, that it would have been obvious to substitute either the carboxyamide of formula II of Claim 16, or the acetamide of Claim 17, for the formamide species set forth in Wagner et al (Answer at 4-5).

In reply, note that the Examiner has not responded to the argument in the Appeal Brief for these claims at page 13 thereof.

Regarding the Examiner's findings concerning the recited amounts of stabilizer compared to the amounts disclosed in Wagner et al, the Examiner points to discussion by the Board (Answer at 5).

In reply, the claims before the Board in the prior appeal did not contain numerical amounts for the stabilizer, and thus the present issue was not before the Board in the prior appeal.

Regarding the separate patentability of Claims 10 and 11, the Examiner points to column 11, line 35ff of Wagner et al, wherein it is disclosed that the amine components can also be, *inter alia*, ammonia or urea. However, these compounds are disclosed as amine components to be used as biuretizing compounds in proportions of about 1 mol to at least 11

Application No. 08/894,156
Reply to Examiner's Answer dated May 19, 2004

mols, and preferably about 12-20 mols of diisocyanate (column 10, lines 12-19). Thus, Wagner et al discloses such compounds in amounts much larger than the presently-recited maximum for such compounds.

Regarding Claim 13, the Examiner finds that the ethylene urea recited therein "is encompassed by" the compounds of Hennig et al at column 2, lines 41-63, and that "analogous" amide compounds are disclosed by Wagner et al at column 9 (Answer at 5).

In reply, ethylene urea is a well-known cyclic compound, and is not encompassed by the substituted ureas of Hennig et al, and is not disclosed or suggested by Wagner et al.

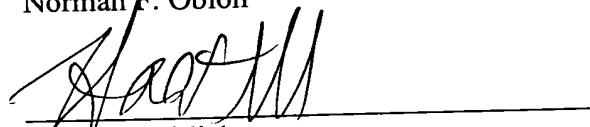
The Examiner finds that the comparative data of record does not "rise to the level of being unexpected," in that Hennig et al discloses that their biurets are "light in color" and that Appellants have not established that "quantitative increases in properties proportional to increases in the amount of component utilized is indicative of an unexpected result," and that it is not seen that the comparative examples that lack a stabilizer such as Comparative Example 12 "are representative of the prior art, since the prior art relies upon such a component" (Answer at 5-6).

In reply, these arguments have already been answered in the Appeal Brief. The Examiner does not respond to them.

For all the above reasons, Appellants continue to submit that all of the rejections of record should be REVERSED.

Respectfully submitted,

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